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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88458681
Applicant	OptConnect Management, LLC
Applied for Mark	OPTCONNECT MANAGED WIRELESS SOLUTIONS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Applications of OptConnect Management, LLC

Application Serial Nos. 88/458,653 and 88/458,681

Trademarks: OPTCONNECT and
OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design

Filing Date: June 4, 2019

APPLICANT’S CONSOLIDATED REPLY BRIEF

In its brief, OptConnect Management, LLC (“OptConnect”) detailed the multiple reasons why confusion is unlikely between its marks OPTCONNECT and OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design and the cited mark OPCONNECT registered by Opconnect, Inc. (“Registrant”). OptConnect’s identification of goods is limited to highly specialized machine-to-machine device networking products and related services. The kiosks for charging electric vehicles specified in the cited registration have different, non-overlapping functionalities, and are sold by different parties in different trade channels to different – and highly sophisticated – consumers. In light of these factors, as well as the differences between the parties’ marks in look, sound, and commercial impression, it’s unlikely that the same consumers will encounter both marks, let alone be confused.

The Examining Attorney’s brief does not rebut OptConnect’s arguments or cite contradictory evidence. It justifies the refusal on the premise that the parties’ goods and services are related because “electric vehicle charging installations are frequently, and often necessarily, connected to the internet of things and other devices” and network connectivity devices and services are often used “in connection with digital signage and advertising as well as for use with other types of kiosks”. However, that fact alone does not mean that the identified goods/services are sold to the same consumers. Indeed, a vast array of modern goods -- from household appliances to office equipment -- are “connected” to the Internet of Things. That fact alone is not enough to show a likelihood of confusion. The Examining Attorney has the burden of showing that the sophisticated customers who purchase the goods defined in OptConnect’s

identification also purchase the EV charging kiosks defined in Registrant's registration through the same marketing channels, and that they would mistakenly think they come from the same source. The brief fails to meet that burden, and ignores the fact that the parties' respective goods are sold to different consumers, for different purposes, at different levels of the supply chain.

As detailed below, OptConnect offers its highly specialized IoT networking goods and services to companies that develop and operate devices that incorporate OptConnect's products and to the technical professionals at the businesses that use the end devices. By contrast, Registrant's finished EV charging kiosks by definition already incorporate "computers, computer hardware, computer peripherals, and computer operating software." OptConnect has submitted extensive evidence showing that such goods are sold to property managers responsible for parking lots at office buildings, apartments, condo complexes, parking lots, and other locations where drivers park their vehicles, and to professionals who manage vehicle fleets. The examining attorney has not shown that these purchasers of completed EV kiosks would also buy OptConnect's goods, the uses of which are explicitly limited to "remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment." OptConnect respectfully submits that the Office has not shown that the marks OPTCONNECT and OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design are likely to be confused with the registered mark, and asks that the refusal be reversed.

ARGUMENT

I. OptConnect's Goods and Services Are Not Complementary, or Otherwise Related to, the Registrant's Goods for Purposes of Establishing Likelihood of Confusion.

The Registrant's identification specifies "Interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging." The Examining Attorney first argues that the registration covers two different products -- kiosks for use in digital advertising (with no connection to electric vehicle charging), as well as kiosks for use in electric vehicle charging. However, that's not a proper reading of the identification. If the Registrant's kiosks were used for two different and unrelated purposes, the identification would have specified "kiosks . . . for use in digital advertising; kiosks . . . for use in electric vehicle charging." See T.M.E.P. § 1401.01(a) ("Semicolons should generally be used to separate distinct categories of goods or services within a single class.").

Regardless, the TMEP is clear that, in cases where the terminology in an identification is unclear or undefined, the Trademark Trial and Appeal Board has permitted an applicant to provide extrinsic evidence to show that the Registrant's identification has a specific meaning to members of the trade. T.M.E.P. § 1207.01(a)(iii) (citing *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) (noting that, "when the description of goods for a cited registration is somewhat unclear . . . it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade.")). Here, the evidence shows that the EV charging kiosks produced by Registrant and its competitors have large video display screens that can present advertising when not providing information about the charging process. They are directly analogous to the screens on gasoline pumps that present advertising while the customer is refueling a car. In addition, the evidence from Registrant's industry also shows that the "kiosks" identified in the cited registration have a specific meaning to members of the trade, i.e., they are kiosks for use in EV charging that also concurrently display digital

advertising targeted to those using the charging devices. Thus, the Examining Attorney's strained interpretation of the identification is contrary to a common sense reading of the language.

Even if the Registrant's identification were read to also apply to kiosks used for digital advertising alone and not for EV charging, one cannot conclude that confusion is likely. There can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. T.M.E.P. § 1207.01(a)(iv) (citing multiple cases involving parties with marks for computer software and/or hardware). Rather, the examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. T.M.E.P. § 1207.01(a)(vi). This is particularly true where one party (in this case, Registrant) offers only goods and the other offers services (as OptConnect does, in Classes 38 and 42); in such a scenario, "something more" than the mere fact that the goods and services are used together must be shown. T.M.E.P. § 1207.01(a)(ii).

Here, the Examining Attorney fails to meet this heavy burden. On pages 15-16 of his brief, the Examining Attorney includes a bulleted list of webpages that allegedly show the relatedness of network connectivity devices to EV charging kiosks. All but one of the webpages, by the Examining Attorney's own admission, show only that EV charging installations frequently require specialized devices to help connect them to the internet. However, Applicant's defined goods do not include IoT devices sold to the manufacturers of EV charging kiosks, nor do they include IoT devices sold to vehicle fleet owners or to landlords that provide EV charging to their tenants or customers. The Examining Attorney's brief does not present a scenario that explains how the Registrant's customers could be confused by OptConnect's use of its mark in selling IoT components to completely different industries.

The refusal focuses almost entirely on the IoT hardware, and not the services, which comprise two of the three classes covered by OptConnect's application. The Examining Attorney has not defined any nexus between Registrant's goods and OptConnect's services.

OptConnect's evidence demonstrates that it sells its identified goods and services to entirely different groups of purchasers than Registrant. Registrant's identification covers finished kiosks that

already incorporate “computers, computer hardware, computer peripherals, and computer operating software” – the package of technology that is needed to connect and operate the kiosk. Thus, one cannot assume that Registrant’s purchasers would have to also purchase connectivity components to incorporate in the kiosks. Consistent with this, Registrant’s specimens and website show a turnkey solution, a completed kiosk ready for installation and charging.

The Examining Attorney provides a single example of a party that purportedly sells both electric vehicle charging devices and “software and connectivity and monitoring services” -- the multinational conglomerate ABB. This evidence shows that the company offers EV charging installations, as well as specialized software and technical assistance for use with these particular installations, all of which is ancillary to the charging installations themselves. The evidence does not show that the company sells the fundamental connectivity devices that would enable the EV charging installations to connect to the IoT.

The Examining Attorney cites a list of webpages that allegedly show that entities who offer network connectivity devices and services offer these goods and services for use in connection with “digital signage and advertising as well as for use with other types of kiosks.” First, the Examining Attorney’s language highlights his attempt to expand the Registrant’s identification to cover all digital signage-related products, rather than only very specific finished kiosks used for digital advertising – thereby inappropriately and impermissibly distorting the nature of the Registrant’s identification. Moreover, while the Examining Attorney’s evidence shows that, theoretically, network connectivity devices can be used with digital signage and kiosks, it does not show that the same customers purchase both the network connectivity devices and the digital signage and kiosks. Of the four bulleted parties whom the Examining Attorney claims sell both kiosks/digital signage and connectivity software or devices:

- Meridian offers “interactive kiosks” and “software” but, as with ABB, this software is not software for connecting devices to the IoT, but rather is kiosk-specific software that is ancillary to the kiosk product.

- AT&T, Cisco, and Verizon offer digital signage solutions, but the evidence does not show the finished kiosks described in Registrant's identification.

Moreover, none of these parties sell kiosks for EV charging which, as detailed above, is central to the Registrant's identification.

The Examining Attorney's brief includes an entirely new allegation never made in the office actions. The brief alleges that "a purchaser of a kiosk commonly connected to the internet of things will likely be made aware of the goods and services that make that connection possible" and argues that "finished products often note that they feature certain components and therefore the mark for the components or software used to support or connect the finished product may appear on the finished products themselves or in advertising the compatibility of the goods with systems for connecting the devices." OptConnect had no opportunity to submit evidence to counter this belated argument, and respectfully submits that it should be excluded from consideration.

Because the Examining Attorney has only offered this argument now, he has not submitted a single piece of evidence in support of either proposition. Indeed, it is far-fetched to believe that the vehicle fleet managers and real estate property managers who purchase the Registrant's finished EV charging kiosks will also be aware of the networking devices and products used in the kiosks or to facilitate their connectivity. However, in the unlikely event that these purchasers are aware of these products, then they are sophisticated enough to avoid source confusion.

II. The Parties' Goods and Services Are Sold Through Different Trade Channels to Different Consumers.

The record shows that OptConnect sells its products to the companies that develop and operate devices that incorporate OptConnect's products, and to the technical professionals at the businesses that use the end devices. By contrast, Registrant sells its electronic vehicle charging systems to professionals who manage vehicle fleets, and to property managers responsible for parking lots at office buildings, apartments, condo complexes, parking lots, and other locations where drivers park their vehicles.

The Examining Attorney argues that OptConnect improperly reads limitations into the trade channels and purchasers of the goods and services of both OptConnect and the Registrant. However, the highly specialized nature of each party's identification inherently results in a limited trade channel and narrow class of potential purchasers of each party's goods/services. OptConnect's M2M and IoT devices networking products are by definition designed for a specialized purpose – the identification specifies that the networking products are “designed to facilitate machine-to-machine communications”, that the hardware is “for running firmware or software designed to facilitate machine-to-machine (m2m) communications and interfaces”, that the microcontrollers and remote control transmitters are “designed for internet of things (iot) enable remote” devices, that the software is “designed for connecting, operating and managing machine to machine (m2m) remote” devices. These are obviously not consumer goods, or even fungible technical components. The identification specifies that they are designed for a particular specialized purpose. The services are similarly complex and specialized.

A layperson simply cannot purchase M2M device networking products from a retail store and incorporate them into or pair them with an ATM, commercial laundry equipment, or agricultural equipment – the process requires both customized assistance from the seller and highly skilled technical professionals on the part of the buyer. Similarly, the average consumer does not walk into a store or visit a website and purchase an EV charging kiosk that also features digital advertising – it is a large and expensive purchase that would be carefully considered and made only by an individual responsible for EV charging at a commercial location.

The Examining Attorney cites *In re I-Coat Co.* and *In re Melville Corp.* to argue that, “in the absence of limitations as to channels of trade or classes of purchasers in the goods and in the registration, the presumption is that the goods move in all trade channels normal for such goods and are available to all potential classes of ordinary consumers of such goods.” However, both of those cases involved applications and registrations specifying goods that an ordinary consumer would buy -- in the case of *In re I-Coat Co.*, lenses and glasses/goggles, and in the case of *In re Melville Corp.*, women's shoes and

women's clothing. Neither case is applicable here, where OptConnect's identification unquestionably describes only complex technical products, and where the parties' channels of trade indeed differ.

III. The Purchasers of Both Parties' Products Are Sophisticated Consumers Who Exercise Significant Care When Making Purchasing Decisions.

As detailed above, OptConnect's customers are (i) sophisticated technology users who incorporate OptConnect's products into their ATMs, vending machines, or other remote-location devices, and (ii) sophisticated technical professionals at businesses who are vitally concerned about M2M communication with their devices in the field. The Registrant's EV vehicle charging kiosks are purchased by professionals who manage vehicle fleets, and to property managers responsible for parking lots at office buildings, apartments, condo complexes, parking lots, and other locations where drivers park their vehicles.

"[Purchaser] sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Elec. Design & Sales v. Elec. Data Sys.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992). Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. T.M.E.P. § 1207.01(d)(vii). OptConnect's goods and services are highly technical and specialized, and require technical expertise to purchase and implement; an EV charging kiosk is a large and expensive purchase, and definitely not an impulse buy. The purchasing circumstances of both parties' products are "circumstances suggesting care in purchasing [that] minimize the likelihood of confusion" under T.M.E.P. § 1207.01(d)(vii).

The Examining Attorney argues that "where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser." That is simply not true. The general public is clearly not OptConnect's market. Its identification explicitly limits its market to "remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment", and none of the goods or services are consumer goods or services. The very nature of OptConnect's network connectivity devices and services limits its prospective purchasers to

narrow markets of sophisticated individuals who would exercise significant care when making purchasing decisions. The same is true of Registrant's EV charging kiosks. The Examining Attorney's argument that the parties' goods may be purchased by even the least sophisticated consumer is not credible, and ignores the actual text of the parties' respective identifications, and the supporting evidence that OptConnect has submitted.

IV. The Parties' Marks Are Significantly Distinguishable, In Light of the Differences Between the Parties' Goods/Services and Trade Channels and the Sophistication of the Parties' Purchasers.

As detailed in OptConnect's Appeal Brief, the Registrant's mark is entitled to only a narrow scope of protection, due to the existence of multiple third-party uses and registrations of or pending applications for CONNECT-formative marks for vehicle charging kiosks and services. Moreover, the prefixes OP- and OPT-create different commercial impressions, due to their distinguishable meanings, and therefore coexist in several marks on the federal register for software – reinforcing that the marks OPTCONNECT and OPCONNECT also may coexist on the register, just as they have coexisted in the market for many years.

The Examining Attorney claims that “similarity in sound *alone* may be sufficient to support a finding that the compared marks are confusingly similar” (emphasis added), but the TMEP states only that “[s]imilarity in sound *is one factor* in determining whether the marks are confusingly similar” (emphasis added). T.M.E.P. § 1207.01(b)(iv). Moreover, the case cited by the Examining Attorney to support that similarity in sound alone may support a finding that two marks are confusingly similar (*In re 1st USA Realty Prof'ls, Inc.*) involved two marks that -- unlike the marks at issue here -- were identical in pronunciation, and other factors in that case also weighed strongly in favor of confusion. Here, the significant differences between the parties' goods/services, and their non-overlapping trade channels and sophisticated purchasers, render the differences between OPTCONNECT and OPCONNECT more than sufficient to permit the marks to coexist in the marketplace – even if the marks are somewhat similarly pronounced.

Additionally, with respect to OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design, while the wording MANAGED WIRELESS SOLUTIONS is disclaimed, “[a] disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks.” T.M.E.P. § 1213.10. Here, the wording MANAGED WIRELESS SOLUTIONS has meaning and significance in communicating the source of the services. “Managed Wireless Solutions” directly references OptConnect’s machine-to-machine wireless connectivity solutions, and unmistakably tells the public that OptConnect uses its mark to help businesses connect devices to each other and to the Internet of Things. In contrast, the wording MANAGED WIRELESS SOLUTIONS has no applicability to the Registrant’s electric vehicle charging kiosks. Thus, someone encountering the OPTCONNECT MANAGED WIRELESS SOLUTIONS logo mark would not assume that a company with that logo has any connection with the Registrant’s business.

CONCLUSION

The Examining Attorney has failed to make any case for refusing registration with respect to the Class 38 or 42 services or the version of the mark that contains MANAGED WIRELESS SOLUTIONS, and has not made a credible case for refusing OPTCONNECT alone in Class 9.

For all of the reasons set forth above, respectfully requests that the refusal be reversed, and the applications be approved for registration on the Principal Register.

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